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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KREMER, MATTHEW J

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,731

Applicant(s)

COLVIN, ARTHUR E.

Examiner

Matthew J Kremer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-11 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 8,12 and 13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/10/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claims 4 and 7 are objected to because of the following informalities. In claim 4, line 2, "a" before "indicator" should be "an". In claim 7, line 2, "a" before "indicator" should be "an". Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,179,767 to Ziegler et al. (Ziegler). Ziegler teaches an implanted sensor 3 with a PMMA shell 3g. (Fig. 2 of Ziegler).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,302,393 to Matsumoto et al. (Matsumoto) in view of U.S. Patent U.S. Patent 5,833,603 to Kovacs et al. (Kovacs)(cited by Applicant). Matsumoto teaches an implanted sensor (column 2, lines 30-50 of Matsumoto) made from polymethyl methacrylate (column 3, lines 14-34 of Matsumoto). Matsumoto does not teach the particulars of the implanted sensor. Kovacs teaches an implanted sensor (Abstract of Kovacs) that would fulfill the requirements of providing an implanted sensor set forth in Matsumoto. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the implanted sensor of Kovacs in the invention of Matsumoto since Matsumoto teaches the use of an implanted sensor and Kovacs teaches one such sensor.

6. Claims 1-7, 9, 11, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent U.S. Patent U.S. Patent 5,833,603 to Kovacs et al. (Kovacs)(cited by Applicant) in view of U.S. Patent 5,730,125 to Prutchi et al. (Prutchi). Kovacs teaches a substrate (40), a first radiation source (60), a first detector (62 and 64), and a first indicator element (56 and 58). (Fig. 3 of Kovacs). Kovacs does not teach a second radiation source, a second detector, and a second indicator element on another side of the substrate. Prutchi teaches that using two sensing mechanisms on different sides of a substrate in an implanted device would eliminate effects due to

sensor motion. (Fig. 9 and column 11, lines 11-21 of Prutchi). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use two sensing mechanisms on different sides of a substrate in an implanted device as disclosed by Prutchi since effects due to sensor motion are eliminated. In regard to claim 1, the second sensing mechanism would include a second radiation source, a second detector, and a second indicator element. In regard to claim 2, LEDs are disclosed. (column 10, lines 56-65 of Kovacs). In regard to claim 3, a sensor body 44 is disclosed. (Fig. 3 of Kovacs). In regard to claim 5, a reference membrane 58 is disclosed. (Fig. 3 of Kovacs). In regard to claim 9, oxygen is determined. (column 10, lines 3-17 of Kovacs).

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent U.S. Patent U.S. Patent 5,833,603 to Kovacs et al. (Kovacs)(cited by Applicant) in view of U.S. Patent 5,730,125 to Prutchi et al. (Prutchi) as applied to claim 4, and further in view of U.S. Patent 5,001,054 to Wagner. Kovacs teaches that that device is used to determine blood sugars. (column 3, lines 32-47 of Kovacs). Wagner teaches that glucose is one such blood sugar. (Abstract of Wagner). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine glucose since Kovacs teaches that blood sugars can be determined and Wagner teaches one such blood sugar.

Allowable Subject Matter

8. Claims 8 and 12-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter. In regard to claim 8, the prior art does not teach or suggest "said indicator molecules from said first and second indicator elements are affected by the presence or concentration of analytes that are different from one another" which is combined or combinable with the other limitations of claim 8. In regard to claim 12, the prior art does not teach or suggest "said first side of said substrate and said second side of said substrate contain regions that are masked" which is combined or combinable with the other limitations of claim 12.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Kremer whose telephone number is 571-272-4727. The examiner can normally be reached on Mon. through Fri. between 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew Kremer
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Art Unit 3736



ERIC F. WINAKUR
PRIMARY EXAMINER